

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Before the Examiner:
Childs et al. : Moazzami, Nasser G.
: :
Serial No.: 10/618,213 : Group Art Unit: 2187
: :
Filing Date: July 11, 2003 : :
: :
Title: AUTONOMIC :
NON-INVASIVE BACKUP AND : Building 675
STORAGE APPLIANCE : 4401 Silicon Drive
: : Durham, NC 27709

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action having a mailing date of May 8, 2006, Applicants respectfully request the formal review of the legal and factual basis of the rejections in this case prior to the filing of an Appeal Brief. A Notice of Appeal is filed concurrently herewith.

REMARKS/ARGUMENTS

Claims 1-7 are pending in the Application. Claims 1-7 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (hereinafter "AAPA") in view of James (U.S. Publication No. 2003/0212862). Applicants respectfully traverse these rejections for at least the reasons stated below.

I. **AAPA and James, taken singly or in combination, do not teach or suggest the following claim limitations.**

Applicants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "a program appliance comprising a program attachable in data communication with the computer; and a data storage appliance attachable in data communication with the computer" as recited in claim 1. The Examiner cites page 6, lines 14-20 of Applicants' Specification as teaching the above-cited claim limitation. Office Action (5/8/2006), page 6. Applicants respectfully traverse and assert that Applicants' Specification instead teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Applicants' Specification, page 6, lines 16-19¹. There is no language in the cited passage directed to prior art that teaches a program appliance comprising a program attachable in data communication with the computer. Neither is there any language in the cited passage directed to prior art that teaches a data storage appliance attachable in data communication with the computer. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

In response to Applicants' above argument, the Examiner focuses on Figure 2 of Applicants' Specification (which by the way is not a Figure describing the prior art) and page 6, lines 16-19 of Applicants' Specification and concludes that the only

¹ It is noted that only lines 16-19 on page 6 of Applicants' Specification refers to the prior art. The rest of the teaching on page 6 of Applicants' Specification refers to the detail description and is not admitted prior art.

difference between the prior art and Applicants' invention is that the backup program is not installed on the hard drive of the computer. Office Action (5/8/2006). The Examiner then states:

Examiner concluded that AAPA discloses all the limitations being claimed, however, AAPA fails to disclose without installing the program from the program appliance into computer's hard drive. In order to overcome the deficiency of the prior art, James discloses a memory device attachable to the computer and containing application software (program) which is configured to run from the memory device upon connection to the host computer rather than being copied onto computer's hard drive or other permanent storage means. Therefore, it would have been obvious to one having ordinary skill in the art having the teaching of AAPA and James to use the teaching of James into AAPA's backup system in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, thereby improving the security. Office Action (5/8/2006), page 3.

Applicants respectfully assert that the Examiner is ignoring the claim limitation of "a program appliance comprising a program attachable in data communication with the computer." Applicants have not addressed the limitation of "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" in the argument above. Instead, Applicants are asserting that the passage cited by the Examiner as allegedly teaching "a program appliance comprising a program attachable in data communication with the computer" does not teach this limitation. Applicants' Specification states:

Generally, pursuant to the invention, the backup program resident on the program appliance 207 directs the computer 203 to copy the files from its hard drive storage system onto the data storage appliance 205. This method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer 203 which would then instruct the computer 203 to copy data from the computer 203 hard drive to a data storage appliance 205. Column 6, lines 14-19.

Hence, the passage cited by the Examiner clearly indicates that the program appliance was not used in the prior art. The Examiner is now relying upon Figure 2 of Applicants' Specification, which does show program appliance 207. However,

Figure 2 is not illustrating the prior art, but instead, an embodiment of the present invention. As a result of the foregoing, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

II. The Examiner's motivation for modifying AAPA with James to include the missing claim limitation of claim 1 is insufficient to establish a *prima facie* case of obviousness in rejecting claim 1.

In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The Examiner admits that AAPA does not teach "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" as recited in claim 1. Office Action (2/01/2006), page 5. The Examiner's motivation for modifying AAPA with James to include the above-cited claim limitation is "in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved²." Office Action (2/01/2006), page 5. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner cites column 6, lines 14-20 of Applicants' Specification for the teaching of AAPA. Office Action (2/01/2006), page 4. Applicants' Specification teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Applicants' Specification, page 6, lines 16-19. The Examiner has not provided any

² The Examiner appears to be citing from [0032] of James.

reasons as to why one skilled in the art would modify AAPA, which teaches a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance, to have program configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive (missing claim limitation of AAPA). The Examiner's motivation ("in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved") does not provide such reasons. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

III. CONCLUSION:

Applicants again submit that the rejections of claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of James are improper. Applicants respectfully request that this case be reopened and that the rejections be withdrawn and a timely Notice of Allowance be issued.

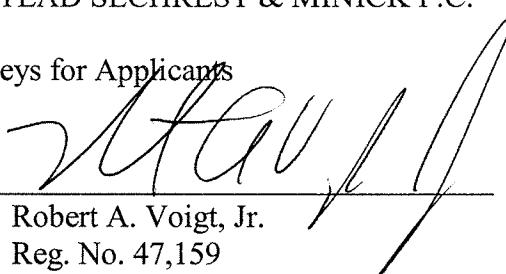
Respectfully submitted,

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